

### **REMARKS**

Applicants have amended the claims to more clearly set forth the scope of the present invention and also to clear up any potential confusion. In particular, Claims 1 and 9 have been amended for merely stating that the images are captured by a customer using a camera instead of providing a camera. Claim 8 has been amended to provide appropriate antecedent basis where none existed. In particular with respect to said information and also has been amended as claims 1 and 9 have been amended.

In the Advisory Action dated January 12, 2004, the Examiner cited In re McLaughlin 170 USPQ 209 in support of the position that it would have been obvious to combine the prior art as suggested by the Examiner. In this regard, Applicant refers the Examiner to In re Lee 61 USPQ 2d 1430 (2002). In particular, at pages 1433 to 1434, CAFC stated: "When patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence to the relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness ... the central question is whether there is reason to combine [the] references .... The factual inquiry to combine references must be thorough and searching ... It must be based on objective evidence of record .... Our case law makes clear that the best defense against a subtle but preferable attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references ... there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by applicant ... teaching of references can be combined only if there is some suggestion or incentive to do so ... the Examiner can satisfy the burden of showing obviousness of the combination ... only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

As Applicants have previously noted, neither Shiota or Leidig teach or suggest the ability to order images prior to receipt of the photosensitive media or the high resolution images as taught and claimed by Applicant. To make the statement that the reference could be used to provide such is not based

on a teaching or suggestion of the prior art, but instead, Applicants respectfully submit is based on hindsight reconstruction. There is no teaching that either references cited that one should or could be combined with the other. The Leidig et al. reference is simply directed to a camera that captures images both electronically and on film. The Shiota et al. reference is simply directed to providing a network photographic service to customers. There is no teaching or suggestion in either of the references to provide the method as taught and claimed by Applicant.

In view of the foregoing, Applicant respectfully submit that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank Pincelli", written over a horizontal line.

Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646